

In The United States Patent And Trademark Office

#117
12/9/02
Allied

Application Number: 09/978,215
Appl. Filed: 10/15/01
Applicant: Luis J. Rodriguez
Title: Self Sealing Forms
Examiner / GAU: Stephen P. Garbe / 3727

Summary of Interview

Type of Interview: Telephonic
Date of Interview: October 29, 2002
Participants: Luis Rodriguez (Applicant)
Stephen Garbe (Examiner)

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TECHNOLOGY CENTER R3700

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

Applicant very respectfully submits a summary of the interview referenced above, as follows:

- 1) Regarding the Advisory Action dated 10/25/02, and particularly the Examiner's allegation that the "elimination of 'at least one', in claim 45 raises a new issue", which was used as the basis to refuse entry of Amendment C, applicant pointed out that Office Action of September 11/02 rejected the same claim 45 under 35 USC 112 for adding "at least", and that therefore refusal to enter Amendment C obviously lacks any proper basis, because "elimination of 'at least one' could only overcome the previous rejection.[*]

Applicant respectfully complained about the contradicting actions of the Office, and indicated that they have had a clearly unfair effect in the prosecution of this case, and particularly referred

[*] So there is no confusion on the record:

Applicant elected to remove "at least" from claim 45, instead of disputing the rejection. The September 11/02 rejection was also improper as there were more than adequate antecedents for the expression "at least" (one body) in the original specification, which disclosed more than one body in the 13th and 14th embodiment examples (Figs. 24's and 25's, and corresponding text), and as extensively discussed in Amendment C.

to this instance, since Amendment C, which contains valuable factual information to explain and advance this case for allowance, was refused entry for one of these improper reasons.

Applicant stated that this case felt like a 'catch 22' situation.

- 2)** Regarding the Office Action of September 11/02, Applicant inquired about Examiner's allegation that the phrase 'relates to a blank' constituted new matter in the substitute specification of Aug. 23/02, and his refusal to enter it, pointing out that 'a blank' was **not** new matter, as it was literally recited by original claim 17, and that therefore refusal to enter the substitute specification was improper.

Applicant also indicated that **ATTACHMENT 17** ("*Cross Reference of Substitute Specification to Original Specification*") discusses each individual amendment made by addition, referencing each entry to the specific location where it was discussed in the original specification, and/or offering a legal explanation where pertinent or necessary.

Examiner indicated that if the clarification regarding 'letter size' (on page 1 of Substitute Specification) was not in the original specification, that it would constitute new matter.

Applicant replied that while new *language* was certainly used, no new matter was introduced (Applicant again referred the Examiner to **ATTACHMENT 17**).

And that the reason for this is that the original title "**Self Sealing Forms**" does not inherently convey the size restricting effects as the term "**Letter**" does, because the term "**Letter**", is commonly used to designate **8½" by 11"** pieces of paper. And that without the clarification, the amended disclosure may be interpreted to apply **exclusively** to forms (or letter sheets) of **8½" x 11"** size, limitation that **was not** in the original disclosure.

And that all this clarification does is to prevent the original disclosure to be unduly restricted to an 8½" x 11" letter size by the Substitute Specification.

Applicant officially and formally re-stated that there is no new matter in the specification as sworn in the "*Statement of No New Matter*" filed with the "*Request for Continued Examination*".

- 3) Only** claims 50 and 68 were discussed. (*The allusion to claim 45 in # 1) above related to the non-entry of the Amendment. Patentability of claim 45 was not discussed.*)

- 4) Regarding claim 50**, applicant referred Examiner to page 39 of Amendment C, which illustrates claim 50 and all its elements as they relate to a drawing of the invention, in its most basic form.

Upon checking the referenced page, Examiner replied: "I won't allow claims of that scope"

Applicant inquired: "*Why not? That is a picture claim.*"

Examiner replied: "*I don't know what you mean by a picture claim*"

Applicant explained —*what (pro-se) applicant has gathered from different readings*— that a 'picture' claim essentially recites each and every element of the invention.

- 5) Regarding Claim 68**, after reading the pertinent locations in original specification, as pointed out by applicant, Examiner admitted that the repositionable adhesive (204) had been disclosed in original specification (which established the invalidity of the rejection, and hence, the allowability of the claim).

However, Examiner stated that applicant should have indicated where the disclosure of repositionable adhesive was.

Applicant indicated that **Amendment C** pointed out to the many different specific locations in original specification where repositionable adhesive (**204**) was discussed.

- 6) Examiner mentioned that the application disclosed many different embodiments.**

Applicant replied that there are no extension limits for a patent application.

Applicant also indicated that applicant has been diligent in addressing all the issues raised by the Office via arguments and/or amendments and that to assist the Office in examining this case, applicant has supplied numerous illustrated materials and visual aids, which graphically summarize the arguments and that judging by the Office Actions, they all appear to have been ignored by the Office.

Applicant respectfully complained about the depth of this case's examination, in view of the incoherence of Office's Actions with respect to applicant's and Office's own previous communications and stated: "It seems as if this case is not being examined at all"

7) Applicant requested that model of invention [submitted under 37 CFR 1.91(a)(3)] be compared with models of Schieman and Wilbur [submitted under 37 CFR 1.91(a)(1)]

8) In response to applicant's complaints, Examiner indicated that any disagreements should be presented to the Board of Appeals and Interferences, for arbitration.

Applicant replied that he intends to take that course of action, but that the refusal to enter the **Amendment C** and the **Substitute Specification** submitted with the Request for Continued Examination, can only be resolved by The Commissioner, upon Petition, and requested that Examiner reconsidered his decisions regarding these matters, so such procedure can be avoided.

Examiner inquired why applicant wanted the Substitute Specification entered.

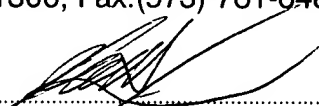
Applicant replied that since it was apparent from Office's Actions that the Examiner has misunderstood the invention, as disclosed in the original specification, the specification needed to be amended to better teach the invention, to the Office and to the public.

Applicant further indicated that as per the MPEP, even if something in the substitute specification is perceived as 'new matter', such new matter needs to a) be properly identified, b) objected to and c) required to be canceled.

Applicant asserted his right to have the substitute specification submitted with RCE (amendment B) entered, especially in light of the fact that it contains no new matter and again referred the Examiner to **ATTACHMENT 17**, which is a cross reference of amendments to their initial discussion in the original specification.

-----END OF SUMMARY OF INTERVIEW-----

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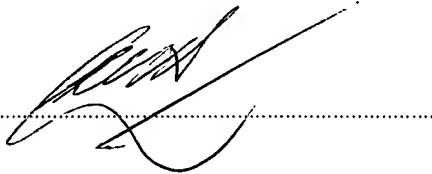
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Luis J. Rodriguez, Applicant

Signed: _____





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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/978,264	
	Filing Date	10/15/01	
	First Named Inventor	Luis J. Rodriguez	
	Group Art Unit	3727	
	Examiner Name	Stephen P. Garbe	
Total Number of Pages in This Submission	7*	Attorney Docket Number	

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Luis J. Rodriguez
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Date	November 22, 2002

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